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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WILMERHALE/NEW YORK		
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NEW YORK, NY 10022		

  

EXAMINER	
DESAI, HEMANT	

  

ART UNIT	PAPER NUMBER
3721	

  

NOTIFICATION DATE	DELIVERY MODE
08/12/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/634,992	<b>Applicant(s)</b> MCERLEAN ET AL.	
	<b>Examiner</b> Hemant M. Desai	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23,30-37,39-51 and 72-107 is/are pending in the application.
- 4a) Of the above claim(s) 106 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 107 is/are allowed.
- 6) ☒ Claim(s) 1-23,30-37,39-51 and 72-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claim 106 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-23, 30-37, 39-51, 72-106 and 107, drawn to system for emptying containers, classified in class 414.
- II. Claim 106, drawn to a method for emptying containers, classified in class 414, subclass 810.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as a control system for controlling the operation of the gripper unit and the cutter or emptying the containers by hand.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 106 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37, 39-43, 45-49, 73-75, 78-80, 83-85, 87, 89-91, 94-97 and 99-100 are rejected under 35 U.S.C. 102(e) as being unpatentable over Browning (6715266) in view of Coughlin (2004/0059463).

Browning discloses an automated system for emptying contents (11, fig. 6) of pharmaceutical containers (10) including medications (11), comprising a gripper unit (140, 144, figs. 7A, 7-B) for receiving and holding a pharmaceutical container (10, figs. 1A, 2-5), a cutter (162, fig. 3) for cutting the pharmaceutical container, a rotating unit (150, figs. 7A-7B) operable with the gripper unit (144) that rotates at least a portion of the gripper unit to empty the contents of the pharmaceutical container.

Browning, as mentioned above, discloses all the claimed limitations, except for an indicia reader that interfaces with the control system. However, Coughlin teaches an indicia reader (282, fig. 13), which interfaces with control system (28, figs. 9 and 13) to retrieve the information about pharmaceutical (paragraph 0031). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the indicia reader that interfaces with the control system as taught by Coughlin in the automated system for emptying contents of Browning to retrieve the information about pharmaceutical.

Regarding claims 2 and 43, Browning discloses a robot (120, 122, figs. 2-6) for placing the pharmaceutical container in the gripper unit.

Regarding claim 3, Browning discloses a conveyor (discharge chute 228, fig. 10B) for transporting the pharmaceutical container in proximity to the robot (102, fig. 1B, see col.5, lines 45-49).

Regarding claims 7 and 45, Browning discloses that the contents of the pharmaceutical container are emptied into a bulk-up container (260, fig. 10A).

Regarding claim 8, Browning discloses that the bulk-up container (260) comprises a substantially uniform sized container (20, fig. 11) to facilitate the automated dispensing of the medications.

Regarding claim 9, Browning discloses that the cutter is an ultrasonic cutter.

Regarding claim 10, Browning discloses that the cutter comprises a blade (162, fig. 3) that moves in a direction substantially parallel to a belt of the conveyor.

Regarding claims 11 and 46, Browning discloses that a rod less air cylinder is used to facilitate movement of the cutter.

Regarding claims 12-13, 34 and 47-48, Browning discloses an arm that rotates to a first position to receive the cut portion of the pharmaceutical container (see fig. 4), and a second position to place the cut portion in a waste repository (see fig. 5).

Regarding claim 14, Browning discloses that the cut portion is released scrap bin (184, fig. 1A).

Regarding claims 15 and 49, Browning discloses a scrap chute (184) that receives a portion of the pharmaceutical container subsequent to emptying the contents of the pharmaceutical container.

Regarding claim 16, Browning discloses that the scrap chute (182, figs. 1A-1B) is in a distal position with respect to the gripper unit prior to emptying the contents of the pharmaceutical container, the scrap chute moving to a proximal position with respect to the gripper unit to receive the portion of the pharmaceutical container held by the gripper unit subsequent to emptying the contents of the pharmaceutical container, the scrap chute returning the distal position to place the portion the pharmaceutical container held by the gripper unit in a scrap bin (184).

Regarding claims 19 and 20, Browning discloses that the gripper unit comprises first and second interlocking fingers (see col. 3, lines 30-33).

Regarding claim 30, Browning discloses, as mentioned above, the automated system for emptying the contents of pharmaceutical containers, comprising means (140, 144) for receiving and holding a pharmaceutical container, means (160) for cutting the pharmaceutical container, means for rotating (150, fig. 7A) at least a portion of the means for receiving and holding to empty the contents of the pharmaceutical container.

Regarding claim 31, Browning discloses means (120) for placing the pharmaceutical container in the means for receiving and holding.

Regarding claim 32, Browning discloses means for transporting (discharge chute 228) pharmaceutical containers in proximity to the means for receiving and holding.

Regarding claim 37, Browning, as mentioned above, discloses the automated system for emptying the contents of pharmaceutical containers, including medications, comprising a gripper unit for receiving and holding a pharmaceutical container, a cutter for cutting the pharmaceutical container and a control system (280, fig. 10A) for controlling the operation said gripper unit and said cutter.

Regarding claim 39, Browning discloses the control system. Therefore a keyboard, control logic, a display, and a processing unit in inherent part of the control system.

Regarding claims 40-42 and 99-100, the system of Browning as modified by Coughlin, as mentioned above, teaches the indicia reader that interfaces with the control system.

Regarding claim 43, Browning discloses the robot (120, 122, figs. 2-6), interfacing with said control system, for placing the pharmaceutical container in the gripper unit.

Regarding claims 73, 78, 83 and 89, Browning discloses that when the container is placed in the gripper unit any cotton can be removed.

Regarding claims 75, 80, 85 and 91, Browning discloses a pill accumulation chute (262).

5. Claims 4-6, 33, 44, 72, 77, 82, 88-89 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughlin as applied to claims 1, 30, 37, 87 above, and further in view of McGrath et al. (6494017).

Browning, as mentioned above, discloses all the claimed limitations, except for a vision system (means for viewing). However, McGrath et al. teach a vision system (3, fig. 20) for rejecting out of shape containers from the conveyors (see col. 4, lines 37-67). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vision system as taught by McGrath et al. in the automated system for emptying contents of Browning for rejecting out of shape containers from the conveyors.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughing as applied to claim 1 above, and further in view of Blaimschein (5318420).

The modified system of Browning, as mentioned above, discloses all the claimed limitations, except for an ultrasonic cutter. However, Blaimschein teaches an ultrasonic cutter to permit an economical and accurate cutting of work-pieces made of any desired polymers or fiber-reinforced polymers with a high efficiency and a low loss of material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ultrasonic cutter as taught by Blaimschein in the automated system for emptying contents of Browning to permit an economical and accurate cutting of work-pieces with a high efficiency and a low loss of material.

7. Claims 17-18, 35, 50, 76, 81, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughlin as applied to claims 1, 30, 37, 87 above, and further in view of Kitamura et al. (5423216).



The modified system of Browning, as mentioned above, discloses all the claimed limitations, except for a sensor system to determine when the contents of the pharmaceutical container are no longer being emptied. However, Kitamura et al. teaches sensor system (7, fig. 4; comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to determine when the contents of the container are no longer being emptied as taught by Kitamura et al. in the automated system for emptying contents of Browning to determine when the contents of the pharmaceutical container are no longer being emptied to activate the discharge chute traverse assembly (180) to expose the bottle to expose the bottle discharge chute (184).

8. Claims 21-23, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughlin as applied to claims 1, 30, 37 above, and further in view of Yuyama et al. (6644504).

The modified system of Browning, as mentioned above, discloses all the claimed limitations, except for detection system to detect the container is no longer being held by the gripper unit. However, Yuyama et al. teaches detection system (sensor 8a, fig. 2a) to detect the container (11, fig. 2a) is no longer being held by the vessel holder (8, fig. 2a). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to detect the container is no longer being held by the gripper unit as taught by Yuyama et al. in the automated

system for emptying contents of Browning to detect the container is no longer being held by the gripper unit.

Regarding claim 23, Browning discloses that the pharmaceutical container can be of different shapes and sizes (see col. 3, lines 30-33).

9. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browning, McGrath et al., Blaimschein, Kitamura et al. and further in view of Lasher et al. (5720154).

Browning, as mentioned above, discloses all the claimed limitations, except for an electronic vision system (means for viewing). However, McGrath et al. teach an electronic vision system (3, fig. 20) for rejecting out of shape containers from the conveyors (see col. 4, lines 37-67). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vision system as taught by McGrath et al. in the automated system for emptying contents of Browning for rejecting out of shape containers from the conveyors.

The modified system of Browning, as mentioned above, meets all the claimed limitations, except for an ultrasonic cutter. However, Blaimschein teaches an ultrasonic cutter to permit an economical and accurate cutting of work-pieces made of any desired polymers or fiber-reinforced polymers with a high efficiency and a low loss of material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ultrasonic cutter as taught by Blaimschein in the automated system for emptying contents of Browning to permit an economical and accurate cutting of work-pieces with a high efficiency and a low loss of material.

The modified system of Browning, as mentioned above, meets all the claimed limitations, except for a sensor system to determine when the contents of the container are no longer being emptied. However, Kitamura et al. teaches sensor system (7, fig. 4; comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to determine when the contents of the container are no longer being emptied as taught by Kitamura et al. in the automated system for emptying contents of Browning to determine when the contents of the container are no longer being emptied to activate the discharge chute traverse assembly to expose the bottle to the bottle discharge chute.

The modified system of Browning, as mentioned above, meets all the claimed limitations, except for an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers in a new bottle. However, Lasher et al. disclose an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers for a patient specific prescription orders (see abstract). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the automated pharmaceutical dispensing system as taught by Lasher et al. in the automated system for emptying contents of Browning to

receive the contents of the pharmaceutical container emptied by the control system and dispense it for a patient specific order.

10. Claims 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughlin as applied to claims 30, 37, 87 above, and further in view of Brazell (5611378) and British Patent (2068829).

The modified system of Browning, as mentioned above, discloses all the claimed limitations of claims 100-103, except for providing vacuum source to collect the dust. However, Brazell and British Patent disclose that it is well known in the art to provide a vacuum source adjacent the cutter to facilitate dust-free cutting. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the vacuum source as taught by Brazell and British Patent in the automated system for emptying contents of Browning to facilitate dust-free cutting.

11. Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browning, McGrath et al., Blaimschein, Kitamura et al., Lasher as applied to claim 93 above, and further in view of Brazell (5611378) and British Patent (2068829).

The modified system of Browning, as mentioned above, discloses all the claimed limitations of claim 104, except for providing vacuum source to collect the dust. However, Brazell and British Patent disclose that it is well known in the art to provide a vacuum source adjacent the cutter to facilitate dust-free cutting. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the vacuum source as taught by Brazell and British Patent in the automated system for emptying contents of Browning to facilitate dust-free cutting.

12. Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browning and Coughlin as applied to claim 37 above, and further in view of Lasher et al. (5720154).

The modified system of Browning, as mentioned above, meets all the claimed limitations of claim 105, except for an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers in a new bottle. However, Lasher et al. disclose an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers for a patient specific prescription orders (see abstract). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the automated pharmaceutical dispensing system as taught by Lasher et al. in the automated system for emptying contents of Browning to receive the contents of the pharmaceutical container emptied by the control system and dispense it for a patient specific order.

***Allowable Subject Matter***

13. Claim 107 is allowed.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-23, 30-37, 39-51, 72-105 have been considered but are moot in view of the new ground(s) of rejection.

Examiner would like to reconsider the affidavit filed under 37 C.F.R. 1.131 on 10/16/2006 to overcome the Browning reference, and would like to apologize for any

inconvenience caused to the Applicant. The affidavit filed under 37 C.F.R. 1.131 is insufficient because the "exhibit A" (drawing) is illegible and Examiner cannot read the reference numbers of the drawings. Further, the drawing does not show the claimed limitations of claims 1, 30, 37, 87 and 93 such as, gripper unit, a cutter, an indicia reader, a control system, a rotating unit etc.

"Exhibit B" also insufficient, because an e-mail stating that the date or postponing the date of "witness testing of the Ultrasonic Bottle slitter" does not provide any evidence or show any thing regarding the claimed invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 6:30 AM-5:00 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hemant M Desai/  
Primary Examiner, Art Unit 3721